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Application Number	10/016,110
Filing Date	December 17, 2001
In re Application of:	Alan Bernard JOHNSTON
Group Art Unit	2145
Examiner Name	Pollack, M.
Attorney Docket Number	RIC01036

Total Number of Pages in This Submission	5	Client Docket Number	09710-1104

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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Signature	*[signature]*
Date	June 5, 2006

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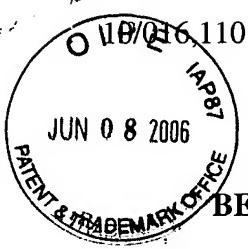
Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Alan Bernard JOHNSTON	
Application No.: 10/016,110	Group Art Unit: 2145
Filed: December 17, 2001	Examiner: Pollack, M.
Customer No.: 25537 Attorney Docket: RIC01036 Client Docket: 09710-1104	

For: PROVIDING CONTENT DELIVERY DURING A CALL HOLD CONDITION

<u>**REPLY BRIEF**</u>

Honorable Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

    This Reply Brief is submitted, in triplicate, in response to the Examiner's Answer mailed April 5, 2006.

    Contrary to the Examiner's Answer, this case is not about whether "the claims as currently drawn do not expressly state a physical separation between the first and second servers" (p. 6). Both the Examiner's references, *Kozdon et al.* (US 6,456,601) and *Flockhart et al.* (US 6,820,260), already show separate servers (servers **10** and **40** in *Kozdon et al.*, and processors **103** and **107** in *Flockhart et al.*). The problem for the Examiner is that these references do not teach or suggest the specific assignment of functions to the servers as recited in the Appellant's claims. In fact, these reference teach against the Appellant's claimed assignment.

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For example, claim 1 provides:

> 1. A data communication system for providing content transmission upon placement of a call on hold, the system comprising:
> a server configured to receive a message from a first client indicating the hold condition of the call with a second client; and
> another server configured to store the content,
> wherein the server is configured to generate a request message, in response to the hold condition, for performing call control on behalf of the first client by transmitting the request message to the other server to instruct the other server to transmit the content to the second client.

Claim 1 thus recites a specific allocation of data communication functions to network elements, in which there are two servers ("a server" and "another server") configured so that the other server is responsible for both storing content and being instructed "to transmit the content to the second client." The applied references, *Kozdon et al.* (US 6,456,601) and *Flockhart et al.* (US 6,820,260), however offer two different and mutually incompatible allocations of functions to their network elements.

The primary reference *Kozdon et al.* is directed to providing "call progress tones in a packetized network" (abstract). For this purpose, *Kozdon et al.* describes the use of a multicast server **10** that is responsible for storing the tones (col. 3:64) and continuously multicasting various music, tones, and announcements to corresponding multicast addresses (cols. 2:46-3:2). When a person at a remote telephone **34** is put on hold by a person at endpoint **24**, the endpoint **24** can redirect the multicast sounds it receives from multicast server **10** to the remote telephone **34**. Alternatively, as shown in FIG. 2, the endpoint **24** can have a proxy **40** be responsible for redirecting the multicast material from multicast server **10** to a remote telephone **34**. In no case, however, does endpoint **24**, much less any other server in *Kozdon et al.*, instruct multicast server **10** to transmit content to remote telephone **34**. Instead, that content is redirected to remote telephone **34** either by endpoint **24** or proxy **40**. Thus, there is no way of modifying *Kozdon et*

al.'s multicasting approach to that of the claims without changing *Kozdon et al.* principle of operation.

On the other hand, *Flockhart et al.* describes an allocation of functions that is **opposite** that of the claims. Specifically, *Flockhart et al.* employs an automatic call distributor (ACD) **107** with a "separate adjunct processor" that includes an executable applet-selection function **103** and applets **97-98** with the directed music or audio programs (col. 3:50-60). After interacting with a client **100** (col. 4:4-6), the "function **103** causes ACD **107** to send that applet **98** to client **100** for execution" (col. 4:47-49). This behavior, however, is opposite that of the claims, which recites "another server configured to store the content" and "transmitting the request message to the other server **to instruct the other server** to transmit the content to the second client." In *Flockhart et al.*, it is the function **103** doing the instructing, not the other way around.

Faced with the fact that the wrong elements of *Kozdon et al.* and *Flockhart et al.* are doing the wrong functions, the Examiner attempts to use the concept of "separation of physical parts" to split the *Kozdon et al.* multicast server **10** into two parts: one to multicast the content and another part to instruct the first part to do it (Examiner's Answer, p. 4, para.49). Left unsaid is which part of multicast server **10** is supposed to store the content. If the *Flockhart et al.* approach is followed, then the same part will do both the content storage and the instruction, contrary to language of claim 1.

Thus, the detailed recitations of the Appellant's claims do not matter because the Examiner holds that "the description above regards and arbitrary separation of functionality in which **any** change may be considered obvious via separation of parts" (Advisory Action of October 14, 2005, emphasis added). To bolster this position, the Examiner's Answer responds to Appellant's arguments by citing—not the documentary evidence of record—but, for the first time

in the examination of this application, the view that server separation is "well known in the art" (Examiner's Answer, p. 6). Yet that concept is what *Flockhart et al.* was supposed to teach (Examiner's Answer's p. 4). The need to introduce this kind of "evidence" at such a late stage of the examination betrays the Examiner's anxiety with *Flockhart et al.*—*Flockhart et al.* also teaches against the particular assignment of functions to the various parts, as set forth in the Appellant's claims.

The Examiner's use "separation of physical parts" doctrine in which application is not merely irrelevant, but a license to disregard the specific limitations of the claims. For these reasons, the Appellant requests the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

DITTHAVONG & MORI P.C.
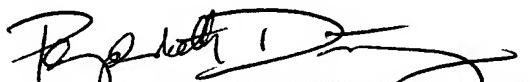
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